

WAND et al.
Application No. 09/936,175
November 12, 2004

REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested. Currently, claims 1-13 are pending in this application.

Information Disclosure Statement:

The Office Action acknowledges receipt of the Information Disclosure Statement (IDS) filed February 5, 2002. However, the Office Action states “a copy of the reference titled ‘Design for Testability in Object-Oriented Systems’ is not available.” This statement contradicts the Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 mailed by the USPTO on October 26, 2001 which explicitly indicates that the copy of the references cited on the ISR has been received (the above-noted reference was cited on the ISR). Nevertheless, Applicant has attached hereto another IDS including another copy of the cited reference.

Drawings:

The drawings were objected to because “it is unclear which Figure(s) the two flowcharts of Figure 3 connect to via C and D connectors and where connectors A and B are?” Fig. 3 has been amended in favor of Figs. 3a and 3b. Figs. 3a and 3b do not include “C” and “D” connectors. Applicant therefore respectfully requests that the objection to the drawings be withdrawn.

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Objections to the Specification and Claims:

The title of the invention has been amended in light of the Examiner's helpful suggestion. The typographical error in claim 8 noted in the Office Action has been corrected. Applicant requests that the objections to the specification and claims be withdrawn.

Rejections Under 35 U.S.C. §112:

Claims 11 and 12 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. By this Amendment, claims 11 and 12 have been rewritten in independent form. Claims 11 and 12 present claims in proper U.S. form. For example, claim 11 properly presents a claim having a "product-by-process" format. Applicant therefore requests that the rejection of claims 11 and 12 under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. §101:

Claims 1-12 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

As noted above, claims 11 and 12 have been rewritten in independent form. Claims 11 and 12 are directed to statutory subject matter. For example, claim 11 recites a claim having a proper "product-by-process" format.

Method claims 1-5 clearly accomplish a practical application in the technological arts. As indicated in MPEP 2106 (IV)(B.)(2)(b)(ii), examples of claimed statutory processes include the following:

“— A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available.

— A method of controlling parallel processors to accomplish multi-tasking of several computing tasks to maximize computing efficiency. See, e.g., *re Bernhart*, 417 F.2d 1395, 1400, 163 USPQ 1,616 (CCPA 1969).

— A method of making a word processor by storing an executable word processing application program in a general purpose digital computer’s memory, and executing the stored program to impart word processing functionality to the general purpose digital computer by changing the state of the computer’s arithmetic logic unit when program instructions of the word processing program are executed.

— A digital filtering process for removing noise from a digital signal comprising the steps of calculating a mathematical algorithm to produce a correction signal and subtracting the correction signal from the digital signal to remove the noise.”

Like the above claimed statutory processes, claims 1-5 are limited to a practical application in the technological arts. “A method of testing...” as required by claims 1-5 is clearly directed to a practical application and is thus statutory under 35 U.S.C. §101.

Similarly, Apparatus claims 6-10 are clearly directed toward statutory subject matter. In particular, claims 6-10 are directed to the practical application of an apparatus for testing an operational integrated software system. Testing an operational integrated software system clearly produces useful, concrete and tangible results. Moreover, the limitations recited in claims 6-10 are supported by,

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for example, tester 201, registry 203, test criteria store 207 and report generator 207 discussed in the specification. (See, e.g., Fig. 2 and page 3, lines 30 to page 4, line 10 and page 7, lines 4-8 of the originally-filed specification).

Applicant therefore respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

Rejections Under 35 U.S.C. §102:

Claims 1-12 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hinckley (U.S. ‘869). Applicant respectfully traverses this rejection.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Hinckley fails to disclose each element of the claimed invention. For example, Hinckley fails to disclose automatically registering each active element of software in a registry, as required by independent claims 1 and 6 and their respective dependents. Hinckley does not teach anything that would even lead one of ordinary skill in the art to provide automatic registration of a software element. Instead, Hinckley teaches automating testing based on a user-defined test specification. This is a much more onerous task.

More specifically, Hinckley (see, e.g., the abstract) describes a test automation system for performing functional tests of a software program in which the test system includes a plurality of test functions, each configured to test a

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discrete component of the software programs, and a user-defined test-specification associated with the program and arranged to provide state definitions which specify a desired test approach for each type of test procedure to be performed on the program...all test-specific and software program-specific data are located in the user-defined test functions.

Col. 6, lines 47-49 of Hinckley states, *inter alia*, “As noted, the user, by means of user interface 209, specifies the type of test that is to be performed by the test automation system 102,” and thus echoes the teachings of Hinckley’s abstract. In contrast, the present invention requires elements to be registered in a register which automatically associates registered elements with an associated test. The present invention provides an automatic test specification rather than requiring a user to define a test specification for each element. Hinckley does not disclose or even suggest the automatic registering of “active elements” of software (“active” being used in its conventional sense to refer to an actually “running” object).

Applicant therefore respectfully requests that the rejection of claims 1-12 under 35 U.S.C. §102 in view of Hinckley be withdrawn.

New Claim:

New claim 13 has been added to provide additional protection for the invention. New claim 13 requires, *inter alia*, “...automatically register each active

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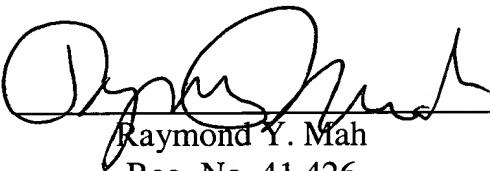
element of the plurality of software elements.” Applicant submits that new claim 13 is allowable.

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 1, 2 and 3. These sheets, which include Figs. 1, 2 and 3, replace the original sheets including these figures. In Figs. 1 and 2, previously omitted labels have been provided to block diagrams. In Fig. 3, labels "C" and "D" have been eliminated and Fig. 3 has been divided into Figs. 3a and 3b.

Attachment: Replacement Sheet(s)
Annotated Sheet Showing Changes

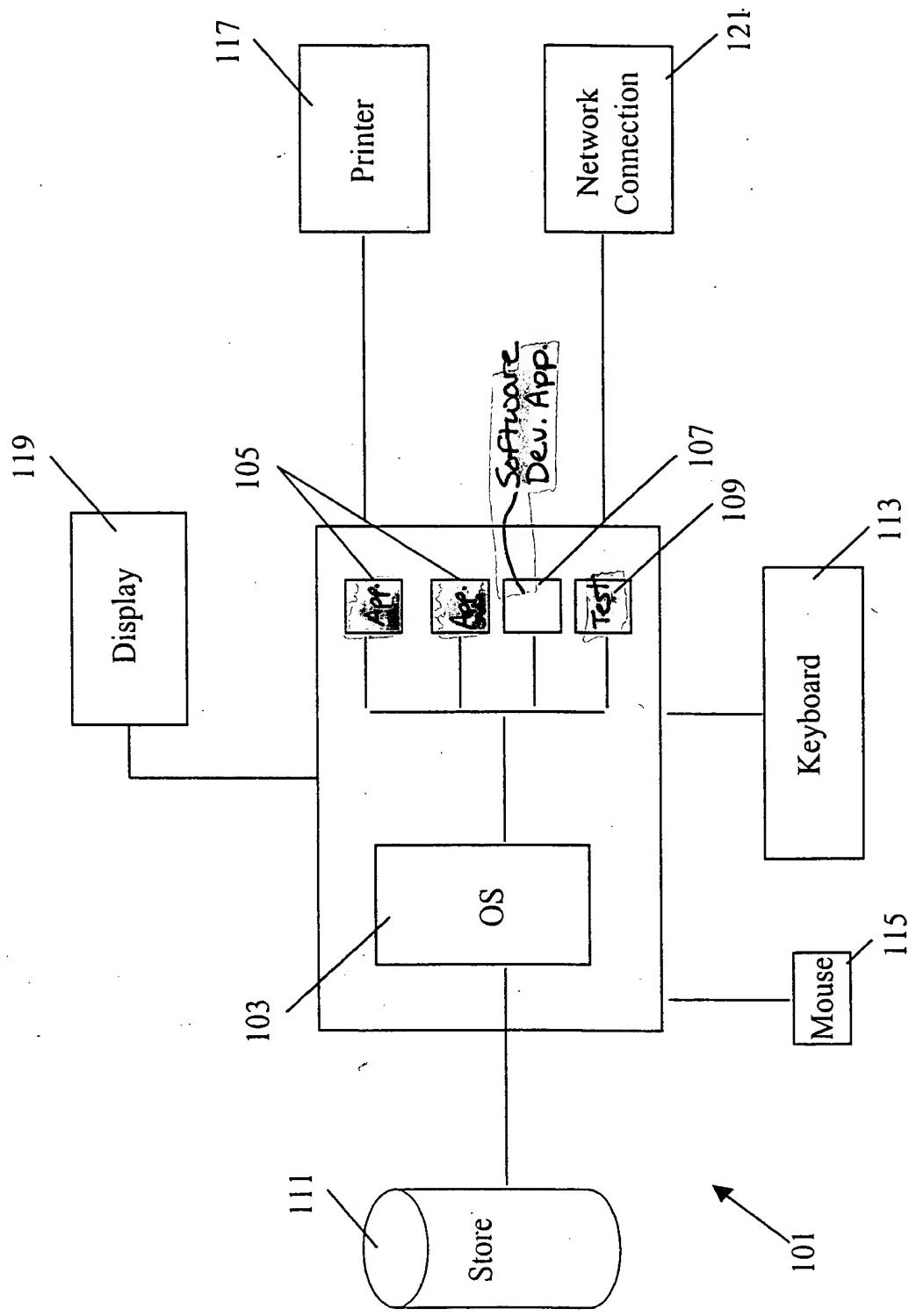


Figure 1

Figure 2

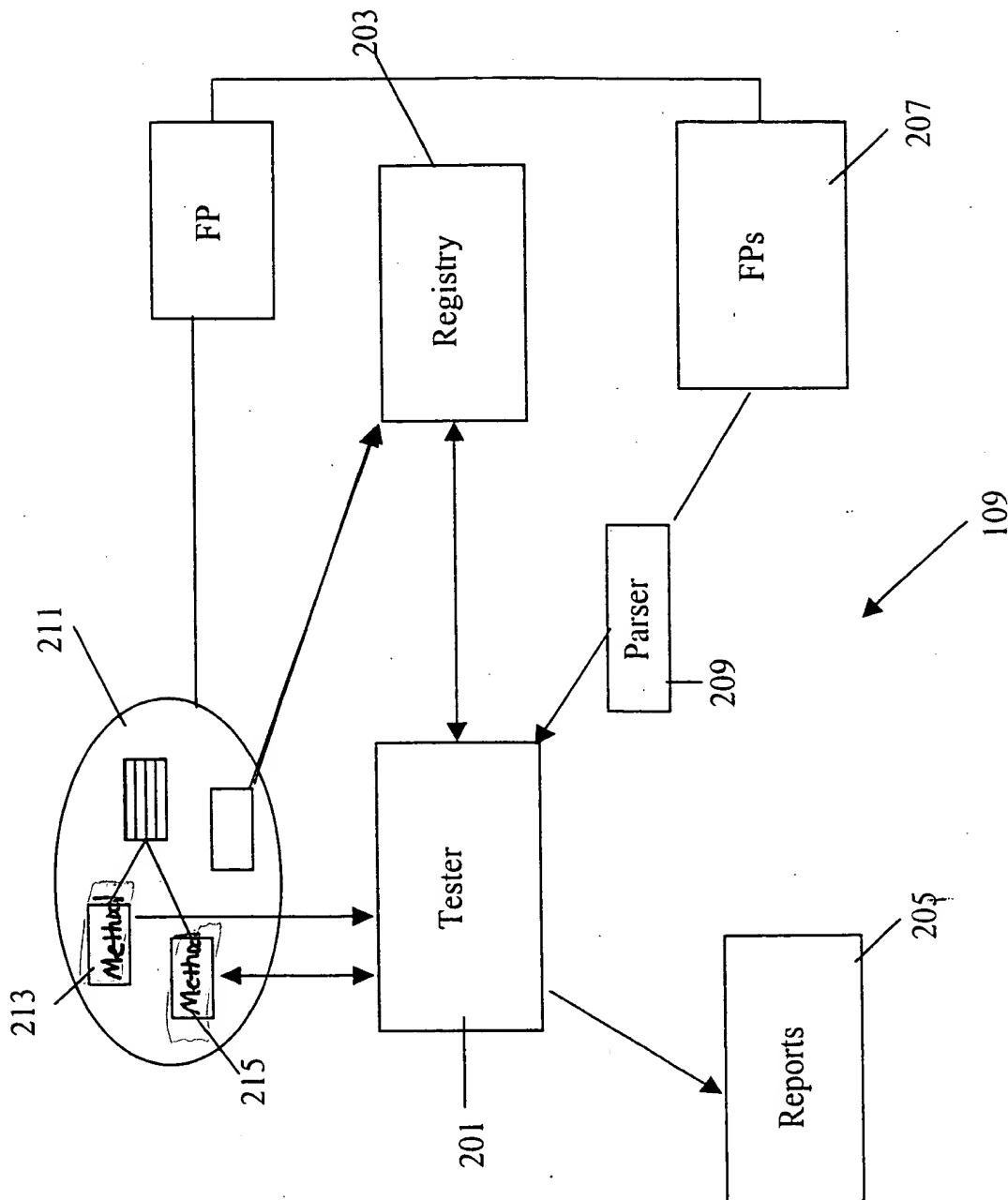


Figure 3b

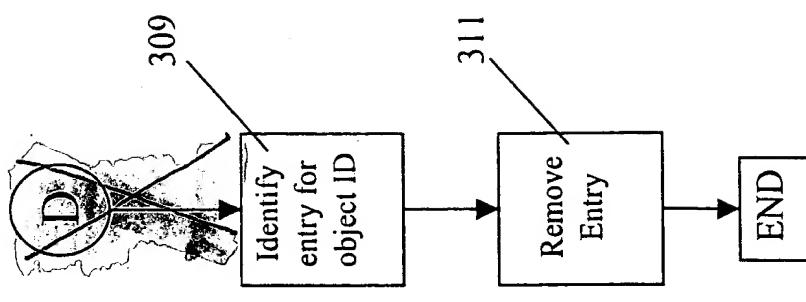


Figure 3a

